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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92064534
Party	Plaintiff Gladium Limited
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Date	10/25/2016
Attachments	Opposition to Motion to Suspend - FINAL.pdf(44443 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 4,537,157
For the mark SEEKING ARRANGEMENT
Registration Date: May 27, 2014

Gladium Limited,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92064534
vs.	:	
	:	
Clover8 Investments Pte. Ltd.	:	
	:	
Registrant.	:	

**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO SUSPEND
PENDING TERMINATION OF CIVIL ACTION**

Petitioner Gladium Limited (“Petitioner”) hereby submits its opposition to Registrant Clover8 Investments Pte. Ltd.’s (“Registrant”) Motion to Suspend this proceeding pending termination of the civil action captioned *Reflex Media, Inc. v. Gladium Limited et al.*, No. 2:16-cv-07395 (C.D. Cal.) (“Civil Action”). Registrant’s motion to suspend proceedings pending termination of the Civil Action is without merit.¹

As TBMP § 510.02(a) explains, to determine whether to grant a motion to suspend pending termination of the Civil Action, the Board “require[s] that a copy of the pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action may have a bearing on the issues before the Board.”

¹ Registrant incorrectly states in its motion that this cancellation proceeding was “commenced by Petitioner after Respondent filed the Civil Action.” 4 TTABVUE 1. This is demonstrably false. The Petition for Cancellation was filed on September 22, 2016 and the complaint in the Civil Action was filed on October 3, 2016.

Based on the pleading submitted by Registrant, it is clear that the Civil Action at this time has no bearing on the issues before the Board. The issue before the Board is the validity of Registration No. 4,537,157 (“Registration”). By contrast, as the pleading in the Civil Action makes clear, while the Registration has been asserted in trademark infringement and related claims therein, the validity of the Registration is not put at issue by the complaint in the Civil Action. There are currently no claims of invalidity of the Registration raised or pending in the Civil Action and thus the resolution of the Civil Action, based on the pleading submitted with the motion, will not affect this cancellation proceeding.

The Civil Action was brought by non-party Reflex Media, Inc., which, according to the complaint, “has been assigned a right to sue on behalf of the owners of the intellectual property.” 4 TTABVue Exh. A, p. 2 n.1. But Reflex Media is not the owner of the Registration and thus, it would be impossible for Petitioner to assert a claim of cancellation in the Civil Action without joining Registrant as a party in the Action. This has not occurred and thus there is no civil action pending at this time that would “have a bearing on the issues before the Board.” TBMP § 510.02(a).

Moreover, because Registrant is not a party to the Civil Action, there is currently no possibility that the Civil Action will result in the Registration being canceled. As many courts have held, cancellation “cannot be obtained from . . . non-registrant/owner defendants.” *Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int’l B.V.*, No. 04 CV 08510 (GBD), 2011 U.S. Dist. LEXIS 100474, at *33-35 n.18 (S.D.N.Y. Sep. 1, 2011) (citing *Van Well Nursery, Inc. v. Mony Life Ins. Co.*, 421 F. Supp. 2d 1321, 1332 (E.D. Wash. 2006) (“[Section 119 of the Lanham Act] suggests that a complaint for trademark cancellation should proceed against the party who currently owns the trademark”); *Iowa Health System v. Trinity Health Corp.*, 177 F. Supp. 2d

897 (N.D. Iowa 2001) (finding that "the owner of the . . . mark [is] thus the only proper [defendant on] a claim for cancellation of the mark"); *Informix Software, Inc. v. Oracle Corp.*, 927 F. Supp. 1283, 1286 (N.D. Cal. 1996) ("Thus, the Court finds that an exclusive licensee of a trademark is not a proper defendant in a suit for cancellation of that trademark. Indeed, the owner of the trademark is the only proper defendant.")).

After reviewing the pleadings submitted with a motion to suspend, the Board has not hesitated to deny such motions where the registrant's right to maintain its federal registration was not at issue in the civil action. For example, in *E. & J. Gallo Winery v. Kendall-Jackson Winery, Inc.*, Cancellation No. 25,965, 2000 TTAB LEXIS 150 (T.T.A.B. Mar. 16, 2000), the respondent moved to suspend the cancellation proceeding pending disposition of a civil action. But the Board denied the motion, holding that, "[h]aving reviewed the pleadings from the state court case, we find that the state court action will not be determinative of respondent's right to maintain its federal registration" *Id.* at *4. As in *Gallo*, resolution of the infringement and related claims in the Civil Action will not, based upon the evidence submitted by Registrant, be determinative as to the validity of the Registration.

For at least the above reasons, Registrant's motion to suspend the instant proceedings pending termination of the Civil Action should be denied.

Dated: October 25, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

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In re Registration No. 4,537,157
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	:	Cancellation No. 92064534
vs.	:	
	:	
Clover8 Investments Pte. Ltd.	:	
	:	
Registrant.	:	

I hereby certify that a true and complete copy of the foregoing Opposition To Registrant's Motion To Suspend Pending Termination Of Civil Action has been served on Registrant's counsel by mailing said copy on October 25, 2016, via First Class Mail, postage prepaid, to:

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